

**REMARKS**

Claims 1-8 and 31 have been examined. Claims 9-30 are withdrawn as being directed to a non-elected invention. The Examiner has indicated that claims 3 and 5-8 contain allowable subject matter.

**I. Rejections under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,022,287 to Klemen et al. ("Klemen") , U.S. Patent No. 5,904,631 to Morisawa et al. ("Morisawa") and U.S. Patent No. 1,918,490 to Riley ("Riley")**

The Examiner has rejected claims 1, 2, 4 and 31 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Klemen in view of Morisawa and Riley.

**A. Claim 1**

Applicant submits that claim 1 is patentable over the cited references. For example, claim 1 recites, "said second electric motor is disposed in a rearmost part with respect to said power splitting planetary gear, said first electric motor, and said transmission disposed along said axis in said casing member; said second rotor of said second electric motor is coupled only with said transmission; and a driving torque of said second electric motor is transmitted with said output shaft only via said transmission."

In the claimed invention, the hybrid drive unit has a first electric motor, a second electric motor, the transmission shifting and transmitting revolution of the second electric motor to the output shaft, and the power splitting planetary gear. The second electric motor is disposed at a rearmost part among the first electric motor, the power splitting planetary gear and the transmission. According to this configuration, the second electric motor is disposed at a rearmost part among the first and second electric motor which are heavy devices, and supported by a vehicle body through a mounting section. As a result, the invention can improve rigidity for

the support of the second electric motor, which rotates at a high speed based on the transmission and cases vibration easily. Thus, vibration transmitted to vehicle body is reduced.

Turning to the cited prior art, Klemen discloses a hybrid driving unit having a first electric motor 24, a power splitting planetary gear 84, 112, a second electric motor 30 and a transmission 170, 192 (Fig. 5). The transmission is disposed at a rearmost part. Thus, contrary to the recitations of claim 1, the second electric motor 30 is not disposed at a rearmost part.

In view of the above, the Examiner cites to Figure 8 of Morisawa. In Figure 8, Morisawa discloses a hybrid driving unit having two electric motors MG1, MG5, a power splitting planetary gear 110 and a reduction gear 310. The first electric motor MG1 is disposed at a rearmost part. Applicant submits, however, that motor MG1 does not correspond to the claimed second motor. Rather, the motor MG5 corresponds to the claimed second motor since motor MG5 is connected to the output shaft 108. Since second motor MG5 is not disposed at a rearmost part, Applicant previously argued that if Klemen and Morisawa were combined, the alleged combination would fail to disclose the claimed invention since neither reference teaches nor suggests a second electric motor that is disposed at a rearmost part (March 31, 2009 Amendment).

In the present Office Action, the Examiner maintains that Morisawa is not cited for specific use of motor MG1 in the rearmost part of the configuration of Klemen, but rather, the Examiner cites Morisawa merely to show that it is within the level of ordinary skill in the art to place a motor at a rearmost location in an assembly (pg. 5 of Office Action). The Examiner also appears to assert a type of rearrangement of parts rationale (pg. 5 of Office Action).

Applicant traverses the Examiner's assertion and submits that one skilled in the art would not be motivated to modify Klemen in view of Morisawa or to rearrange the parts of Klemen.

As set forth in MPEP § 2144.04, the mere fact that the parts of a reference *can* be rearranged is not by itself sufficient to support a finding of obviousness, rather “[t]he prior art must provide a motivation or reason for the worker in the art, without benefit of appellant’s specification, to make the necessary changes in the reference device.” (emphasis added) *Ex parte Chicago Rawhide Mfg. Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pat. App. & Inter. 1984).

In Klemen, the rotor 34 of the second motor 30 is connected not only with a sun gear shaft 168 of the transmission, but also with a sun gear shaft 148 of the power splitting planetary gear 112. Thus, a driving torque of the second electric motor is transmitted with the output shaft not only via the transmission, but also via the power splitting planetary gear 112. If the second motor 30 were disposed at a rearmost part, the rotor 34 of the second motor 30 could not be connected with the sun gear shaft 148 of the power splitting planetary gear 112 because the transmission is obstructive. Accordingly, it would be impossible to dispose the second motor 30 at a rearmost part, because the relationship of the second motor connection recited in claim 1 cannot be achieved.

At least based on the foregoing, Applicant submits that even if Morisawa discloses a motor in a rearmost part, one skilled in the art would not be motivated to rearrange the configuration of Klemen.

Since Riley fails to cure the deficient teachings of Klemen and Morisawa, Applicant submits that claim 1 is patentable over the cited references.

**B. Claims 2, 4 and 31**

Since claims 2 and 4 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency. Also, since the features of claim 31 have been incorporated into claim 1, Applicant has canceled claim 31 without prejudice or disclaimer.

## II. Allowable Subject Matter

As set forth above, the Examiner has indicated that claims 3 and 5-8 contain allowable subject matter, but are objected to as being dependent upon a rejected base claim.

## III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

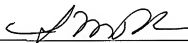
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**23373**

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Date: September 29, 2009

  
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